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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YUN, EUGENE

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/595,114	<b>Applicant(s)</b> KIMURA ET AL.	
	<b>Examiner</b> Eugene Yun	<b>Art Unit</b> 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5-7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (US 4,648,037) in view of Hoffer (US 5,799,151).

Referring to Claim 1, Valentino teaches a system for the provision of benefits data to benefit recipients (see ABSTRACT) across an electronic portal, wherein said system comprises:

an electronic portal network for provision of said benefits data to benefit recipients 24 and 26 (fig. 4); and

a client based computer system for sending signals to be transmitted to said electronic portal network and for receiving said signals transmitted from said electronic

portal network 20 (fig. 4), together for requesting and accessing said benefit resources data (see col. 2, lines 4-10).

Valentino does not teach a wireless network connected to said electronic portal network for receiving signals to be transmitted to said electronic portal network and for sending signals to be transmitted from said electronic portal network. Hoffer teaches a wireless network connected to said electronic portal network for receiving signals to be transmitted to said electronic portal network and for sending signals to be transmitted from said electronic portal network (see Claim 14 of Hoffer). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

Referring to Claim 6, Valentino teaches a method for providing benefits data to benefit recipients across an electronic portal, wherein said method comprises the steps of:

matching said benefit data with at least one benefits recipient (see col. 4, lines 9-16);

ascertaining at least one benefit to be represented by said benefit data (see col. 4, lines 16-23);

providing an electronic portal network for access of said benefits data to benefit recipients 24 and 26 (fig. 4);

receiving signals to be transmitted to said electronic portal network; and

sending signals to be transmitted from said electronic portal network (see arrow between 27 and 24 of fig. 4) and processing said signals by use of a client based computer system for sending said signals to be transmitted to said electronic portal network and for receiving said signals transmitted from said electronic portal network 20 (fig. 4), together for requesting and accessing said benefit resources data (see col. 2, lines 4-10).

Valentino does not teach a wireless network connected to said electronic portal network for receiving signals to be transmitted to said electronic portal network and for sending signals to be transmitted from said electronic portal network. Hoffer teaches a wireless network connected to said electronic portal network for receiving signals to be transmitted to said electronic portal network and for sending signals to be transmitted from said electronic portal network (see Claim 14 of Hoffer). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

Referring to Claims 2 and 7, Valentino also teaches at least one benefits provider and a third party enterprise for coordinating the access and provision of benefits to the benefits recipients (see col. 4, lines 33-38).

Referring to Claims 5 and 10, Valentino also teaches said benefits providers selected from a group comprising:

Investment providers, health benefits providers, retirement benefits providers, exercise benefits providers, travel benefits providers, food benefits providers, child care

benefits providers, housing benefits providers, and discount goods and services benefits providers (see col. 14, lines 2-18).

Referring to Claim 11, Valentino also teaches providing a reduced costs outsourcing, and offering at least one discount on benefits which reduced the costs of administering said benefits from a benefits provider to the benefits recipient by said third party provider (see col. 15, lines 14-26).

4. Claims 3, 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino and Hoffer in view of Dahm et al. (US 6,466,783).

Referring to Claims 3 and 8, Valentino teaches said benefits as employment related benefits (see ABSTRACT). The combination of Valentino and Hoffer does not teach said benefits accessible to the benefits recipients through a PDA. Dahm teaches said benefits accessible to the benefits recipients through a PDA (see col. 2, lines 3-9 noting that access to the WWW by said PDA as shown in fig. 2A enables the user to access employee related benefits). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Dahm to said system of Valentino in order to better provide access to employee related benefits regardless of location.

Referring to Claims 4 and 9, Dahm also teaches said PDA displaying web pages according to the WAP standard (see 264 of fig. 2B).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Eugene Yun  
Examiner  
Art Unit 2683

EY  
December 13, 2002

  
WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600